

PATENT
SERIAL NO. 10/786,974

REMARKS

The Examiner has required restriction of the claims to three groups. Claims 1-8 in Group I; Claims 9-13 in Group II; and Claims 14-16 in Group III. Applicant respectfully elects Group I with traverse. Applicant respectfully submits that the tarnish resistance corrosion resistance improving alloy in Group II, and the process claimed in Group III can only be used to manufacture the silver alloy of Group I. Accordingly, reconsideration is requested.

Claim 1 has been objected to because the claim language includes the term "approximately $29.75\% \pm 5\%$ by weight of zinc. The Examiner has suggested that the aforesaid \pm refers to 5% of 29.75%. However, as seen in Paragraph 12, lines 8-10, of the specification, indicate that the range is actually 24-34% zinc. Similarly, a range of 60-74% copper, 0.5-1.8% silicon, 0-8% tin and 0-1.5% indium are disclosed. Accordingly, the claims have been amended to conform to this range.

The Examiner objected to the term "consisting essentially of" and "comprising" transitional phrases. Accordingly, the claims have been amended to utilize the transitional phrase "consisting essentially of".

Claims 1-8 stand rejected under the 35 U.S.C. §103(a) over the patent of Eccles in view of the patent of Bernhard. This rejection is respectfully traversed.

As indicated in the telephone conversation with the Examiner on November 23, 2004, the patent of Eccles, while it does incorporate silver, zinc, copper, silicon and tin in ranges which overlap the present invention also contains Germanium. As indicated in Column 2, lines 30-37, "the Germanium content of the alloy has surprisingly resulted in alloys having work hardening characteristics of a kind with those exhibited by conventional 0.925 silver alloys, together with the firescale resistance of the hereinbefore described firescale resistant alloys. In general, it has been determined that amounts of Germanium in the alloy of from about 0.04 to 2.0% by weight provide modified work hardening properties relative to alloys of the firescale resistant kind not including Germanium." Thus Germanium is material to the properties of the Eccles patent. The present invention utilizes the transitional phrase "consisting essentially of." Thus, a requirement

PATENT
SERIAL NO. 10/786,974

of Germanium in the Eccles alloy distinguishes from the present invention by providing modified work hardening properties.

Similarly, the patent of Bernhard requires the addition of Boron. As indicated in Column 3, lines 64-66, of Bernhard, "Boron is added to reduce the surface tension of the molding alloy and to allow it to blend homogenously."

Thus, since the present claims describe an alloy consisting essentially of, the addition of Germanium and/or Boron to the alloy, is materially different than the present invention and neither teaches, suggests nor implies the alloys of Claims 1-8 of the present invention, which are manufactured without the surface tension and blending properties of Boron or the work hardening characteristics of Germanium. In point of fact, both of these references teach away from use and manufacture of an alloy without either Germanium or Boron. Accordingly, reconsideration and allowance is respectfully requested.

Accordingly, Applicant respectfully submits that the claims are in condition for allowance, and request that an early notice of allowance be issued in this application. The Examiner is invited to contact the below-listed attorney at 312/609-7848 if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

Date: November 24, 2004

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